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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/958,614	10/27/97	MORANDO J	MJV106B1CIP

IM41/0727

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EXAMINER	
YEE, D	
ART UNIT	**PAPER NUMBER**
1742	2

DATE MAILED: 07/27/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-21 is/are pending in the application.

Of the above, claim(s) 7-15 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-6 and 16-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner. Missing Abstract. Need to submit.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

– SEE OFFICE ACTION ON THE FOLLOWING PAGES –

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 16-21 are, drawn to an alloy composition, classified in class 420, subclass 586.

II. Claims 7-15 are, drawn to an article submerged in a zinc/aluminum alloy melt , classified in class 428, subclass 653.

2. The inventions are distinct, each from the other because of the following reasons: Inventions of group II and group I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not depend for its patentability on the details of the subcombination. The subcombination has separate utility such as structural components in the form of bar or tube.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Charles Chandler on July 16, 1998 a provisional election was made with traverse to prosecute the invention of group I, claims 1-6 and 16-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application 2128633.

The reference teaches a steel alloy with constituents whose wt% ranges overlap those recited by the claims; such overlap renders applicant's composition prima facie obvious despite differences in non-overlapping ranges, see In re Malagari, 182 USPQ549.

Although prior art does not teach an article intended to be submerged in molten zinc and aluminum/zinc melts as recited by the claims, such would not be a patentable difference since it is merely applicant's future and intended use.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "selected element".

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is (703) 308-1102.

Deborah Yee

DEBORAH YEE
PRIMARY EXAMINER
GROUP 1300

dy

July 20, 1998